

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 1, 9, 11-13, 20, and 23 are amended, claim 10 is canceled, and new claims 33-35 are added. Claims 1-9 and 11-35 are now pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

#### **A. Claim Amendments and/or Cancellations**

With particular reference to the claim amendments, Applicants note that while claims 1, 9, 11-13, 20, and 23 have been amended herein, and claim 10 has been canceled herein, such amendments and cancellation have been made in the interest of expediting the allowance of this case. Notwithstanding, Applicants, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicants hereby reserve the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicants submit that neither the claim amendments set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicants in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

#### **B. Remarks**

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

## **II. Rejection of Claims 1-7, 9, 10, and 12 under 35 U.S.C. § 102**

Applicants respectfully note that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP* § 2131.

The Examiner has rejected claims 1-7, 9, 10, and 12 under 35 U.S.C. § 102(e) as being purportedly anticipated by U.S. Patent No. 6,424,627 to Sorhaug et al. (“*Sorhaug*”). Applicants respectfully disagree with the contention of the Examiner but submit that for at least the reasons set forth below, the rejections of claims 1-7, 9, 10, and 12 should be withdrawn. Of the rejected claims, claim 1 is the sole independent claim.

By this paper, Applicants have amended independent claim 1 to recite “...a routing node that is in communication with the first port and the second port, the routing node being configured to pass network data between the first port and the second port, the routing node being further configured to insert data into the network data stream while avoiding data collisions within the network data stream...” Support for this amendment to claim 1 can be found in various places in the application, including at paragraphs [0052] and [0053].

In contrast, Applicants respectfully submit that the Examiner has not established that the cited reference teaches or suggests all the claim limitations of amended claim 1, at least because the Examiner has not established that each and every element as set forth in claim 1 is found in *Sorhaug*, because the Examiner has not established that the identical invention is shown in *Sorhaug* in as complete detail as is contained in claim 1, and because the Examiner has not shown that *Sorhaug* discloses the elements arranged as required by claim 1. Applicants thus respectfully submit that the rejection of claim 1, as well as the rejection of corresponding dependent claims 2-7, 9 and 12, should be withdrawn. Inasmuch as claim 10 has been canceled herein, the rejection of that claim is moot and should likewise be withdrawn.

Applicants note that in the rejection of claim 6 the Examiner simply states that the *Sorhaug* transceiver “inherently includes a microprocessor.” Office Action at p. 3, emphasis added. Furthermore,

in the rejections of claims 7 and 12, the Examiner respectfully states that the *Sorhaug* transceiver “could comprise a field programmable gate array,” and the transceiver and MUX “could be provided by a field programmable gate array.” *id.*, emphasis added. Thus, in the rejection of claim 6 and, it appears, in the rejections of claims 7 and 12 as well, the Examiner is relying on a theory of inherency. Applicants respectfully note, however, that inherency is not readily established.

In particular, as noted in MPEP § 2112, the Examiner must provide rationale or evidence showing inherency. In particular, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient’.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Finally, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

With the foregoing in view, Applicants respectfully submit that the Examiner has failed to establish that *Sorhaug* inherently discloses the claimed microprocessor and FPGA and, for at least this reason, the rejections of claims 6, 7 and 12 are not well taken and should be withdrawn.

### III. New Claims 33-35

By this paper, Applicants have added new dependent claims 33-35. New claims 33-35 are believed to be allowable at least by virtue of their dependence from claim 1. Support for the new claims can be found in the application at, for example, paragraphs [0051] and [0054].

### IV. Allowed Subject Matter

The Examiner’s allowance of claims 14-32 is appreciated. Applicants wish to thank the Examiner for the careful review and allowance of those claims. Applicants note that claims 20 and 23 have been amended herein to correct grammatical errors that do not affect patentability.

The Examiner has indicated that claims 8, 11, and 13 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In light of the discussion set forth herein, Applicants respectfully decline to rewrite those claims in independent form at this time.

**CONCLUSION**

In view of the remarks submitted herein, Applicants respectfully submit that each of the pending claims 1-9 and 11-35 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 17th day of June 2008.

Respectfully submitted,  
/Peter F. Malen, Jr./Reg.# 45576

---

Peter F. Malen Jr.  
Registration No. 45,576

Scott A. Woodbury  
Registration No. 55,743

Attorneys for Applicants  
**Customer No. 022913**  
Telephone: (801) 533-9800

C:\NRPORTBL\DMS1\MMCCLELLAND\1691384\_1.DOC